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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,806	03/17/2000	AKIHIKO IBATA	MEIC:070	7172

7590 09/12/2002

PARKHURST & WENDEL
1421 PRINCE STREET
SUITE 210
ALEXANDRIA, VA 22314-2805

EXAMINER

POKER, JENNIFER A

ART UNIT	PAPER NUMBER
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2832

DATE MAILED: 09/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/423,806

Applicant(s)

IBATA ET AL.

Examiner

Jennifer A. Poker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 8. 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is in excess of 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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5. Claims 1-9, 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states, "a spiral strip of conductor and a plurality of terminals formed in close contact with an external peripheral surface of said capacitor or an external peripheral surface of said insulation layer not comprising said capacitor and having no electrodes disposed thereon". This claim was not clear. It was understood what the applicant meant by "...said insulation layer not comprising said capacitor..." This contradicts the first limitation of the claim when the applicant states that the capacitor comprises at least one insulation layer. The examiner understood the claim to mean that the spiral strip of conductor and plurality of terminals may be found on an external peripheral surface of the capacitor or on an external peripheral surface of one of the insulation layers, which the capacitor comprises. It was understood in this manner simply because the first limitation of claim one stated that the capacitor was comprised of at least one insulation layer.

Claim 2 recites the limitation "the same material". There is insufficient antecedent basis for this limitation in the claim.

Claim 3 states, "...wherein a spiral axis...is parallel with said electrode layers comprising said capacitor". The phrase "comprising said capacitor" makes this claim ambiguous. The elimination of phrase is suggested.

Claim 5 states, "...spiral strip of conductor is electrically connected at two ends...". It was understood by the examiner that the conductor was electrically connected at two ends of the capacitor.

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Claim 6 states, "...at least one of said electrode layers comprising said capacitor..." The phrase "comprising said capacitor" makes this limitation ambiguous. The elimination of the phrase is suggested.

Claim 10 states, "...spiral strip of conductor is parallel with said electrode layers comprising said capacitor..." The phrase "comprising said capacitor" makes this limitation ambiguous. The elimination of the phrase is suggested.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being unpatentable by U.S. Patent Number 4,322,698 to Takahashi, et al.

Takahashi, et al, discloses laminated electronic parts for an inductor or a capacitor comprising:

- (1) A plurality of insulating layers including insulating or insulated magnetic layers or dielectric layers. (Abstract)
- (2) A plurality of electrically conductive layers in the form of a coil or coils. (Abstract)
- (3) Terminals attached to edges of the electronic part, where edges of conductive layers are connected. (Column 3, lines 40-45) (Figure 45)

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Regarding claim 2, Takahashi, et al, states that the conductor to be used for forming the conductive patterns is a paste and the conductor for forming the external connecting terminals may be the same conductive paste. (Column 3, lines 40-45)

Regarding claim 3, Takashi, et al, states that the coils/conductors are located on the electrically conductive layers, therefore it is understood that the coils are parallel to the layers. (Abstract)

Regarding claim 4, Takahashi, et al states that the electronic part includes one or more capacitors in some embodiments. (Column 2, line 1)

Regarding claims 5 and 6, it is apparent by figures 13 and 28-31 that the conductor is connected to the terminals located on the sides of the capacitor.

Regarding claim 7, both top and bottom layers are insulation layers. (Claim 1 and column 2, lines 3-13)

Regarding claims 8 and 9, the insulator sheets used may be formed by varied procedures using a powder of a magnetic (conductive) material with or without an insulating property or the powder of a dielectric material. (Column 3, lines 15-20)

Regarding claim 10, Takahashi, et al, discloses laminated electronic parts for an inductor or a capacitor comprising:

- (1) A plurality of insulating layers including insulating or insulated magnetic layers or dielectric layers. (Abstract)
- (2) A plurality of electrically conductive layers in the form of a coil or coils, (coils are connected to layer and are also parallel to layer). (Abstract)
- (3) Terminals attached to edges of the electronic part, where edges of conductive layers are connected. (Column 3, lines 40-45) (Figure 45)

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- (4) Conductive layers/coil laminated with an insulation layer one after another.

(Column 2, lines 3-13)

Claims 11-19 and method counterparts to product claims 1-10, and steps, as such, are inherent for fabricating a component comprising a capacitor with a plurality of insulation layers, conductive layers, and external terminals.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Number 5,476,728 to Nakano, et al, discloses a multi-layer LC composite part including a plurality of insulation layers and a plurality of electrode layers.

U.S. Patent Number 6,147,573 to Kumagai, et al, discloses a multi-layer electronic part formed by superposing coil conductors and green sheets of magnetic or nonmagnetic material.

U.S. Patent Number 5,197,170 to Senda, et al, discloses an LC composite part comprising a plurality of capacitor electrodes formed thereon such that the ceramic sheets and electrode layers alternate.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Poker whose telephone number is 703-305-4037. The examiner can normally be reached on 6:00-3:30, Mon.-Fri. (alternating Fridays off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin G. Enad can be reached on 703-308-7619. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3432 for regular communications and 703-746-8181 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 730-308-5115.

jap
September 3, 2002


ELVIN ENAD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800
9/6/02